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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/414,710 10/08/99 FABER

S 9997-003

EXAMINER

TM02/1121

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ART UNIT

PAPER NUMBER

2163

DATE MAILED:

11/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/414,710

Applicant(s)  
Faber et al.

Examiner  
Susanna Meinecke-Díaz

Group Art Unit  
2163



☒ Responsive to communication(s) filed on Apr 4, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4,6,7,11,12

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

1. Claims 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104 are currently pending.

#### ***Information Disclosure Statement***

2. The Examiner has reviewed all Information Disclosure Statements submitted by the Applicant, except for the one which has been labeled as paper no. 10 on the file wrapper, but which the Examiner cannot locate within the case. Please resubmit just the corresponding PTO-1492 form and any cited non-patent literature. The Examiner will print out any cited U.S. and Foreign Patents. The Examiner apologizes in advance for this inconvenience.

The Examiner is sending the Applicant a copy of all PTO-1492 forms reviewed and signed by the Examiner (paper nos. 4, 6, 7, 11, and 12).

#### ***Specification***

3. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(1). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104 are rejected under 35

U.S.C. 102(a) as being clearly anticipated by the Internet service Expertcity.com, which was made public on August 30, 1999. The following references support this rejection:

“Expertcity.com Launches Premier Online Marketplace for Expert Services” (published August 30, 1999)

“Rent-An-Expert On the Web” (published September 9, 1999, but states that Expertcity.com was launched “last week”)

Information about Expertcity.com retrieved from the Internet [URL: <http://www.expertcity.com>] (exemplifies the disclosure in the two preceding articles)

6. Claims 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/488,130 which has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application.

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This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 44-46, 48-51, 53-68, 70-88, 90-92, 97, and 104 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 101-105, 107-111, 113, 115-128, 130, 132-146, 149, 150, and 157 of copending

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Application No. 09/488,130. Although the conflicting claims are not identical, they are not patentably distinct from each other because overall the same limitations are cited in both applications. Only the claim dependencies are slightly different. In other words, the disclosure in the claims alone of the earlier filed application (Application No. 09/488,130) will be sufficient to reject all of the claims of the present invention under 35 USC 102(e) once the patent corresponding to Application No. 09/488,130 issues.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(A) The following references disclose the Assignee's (Keen.com) Live Answer Community:

Information about Keen.com retrieved from the Internet [URL: <http://www.keen.com>]

"Net Firm to Connect Users By Phone"

"Keen.Com Launches First Live Answer Community"

"From A to Z, You Can Sell Advice Online"

"An Expert? There's Now a Home for You on the Internet"

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(B) The following references discuss the concept of providing online users/shoppers with an instant call button to connect with a customer service representative via the Internet (e.g., a voice connection):

“USA Global Link Brings Interactively to Internet Shopping”

“Lucent Technology and Netscape Team to Deliver Lucent ECommerce Solutions”

“TriNet's 'Help Me, I'm Stuck' Internet Voice Button Service Pushes Web Pages to Online Users”

“e-Rip Van Winkle and the 60-Second Nap”

“NetCall Internet Call-Buttons Enhance E-Commerce Customer Service and Sales”

“Connecting to On-Line Car Shoppers: Auto Sellers Use NetCall Internet Call-Button Technology to Turn 'Clicks' into Interactive Sales”

“Wheeling and Dealing Online”

“Why Online Browsers Don't Become Buyers”

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Meinecke-Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at (703) 305-9643.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SMD

November 17, 2000



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SUPERVISORY PATENT EXAMINER  
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